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REMARKS

This is a full and timely response to the outstanding Office action mailed September 29, 2005. Upon entry of the amendments in this response claims 1, 2, 4-21, and 23-28 are pending.

I. Present Status of Patent Application

Claims 1-2, 4-21, and 23-28 are rejected under 35 U.S.C. 103(a) as allegedly obvious over *Hiroki, et al* (U.S. Patent No. 6,594,032) in view of *Cortright, et al* (U.S. Patent No. 6,895,426), including a finding of Official Notice regarding claim 1. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. These rejections are respectfully traversed.

II. Examiner Interview

Applicant first wishes to express sincere appreciation for the time that Examiner Vu spent with Applicant's representatives Jeff Kuester and Benjie Balser during an October 26, 2005, telephone discussion regarding the above-identified Office Action. Applicant believes that various features described in the patent application and recited in the claims, including otherwise generating a prompt for a user to confirm an email address were discussed during the telephone discussion, and that the outcome of this discussion is addressed herein. Examiner Vu also introduced two new references (6,449,657 to *Stanbach, et al* and 6,332,158 to *Risley, et al*) that he indicated Applicant could address to advance the prosecution of the application. During that conversation, Examiner Vu seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Vu carefully consider this amendment and response.

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III. Rejections Under 35 U.S.C. §112**A. Claim 26**

The Office Action rejects claim 26 under 35 U.S.C. §112 as allegedly being "indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. (i.e., the checker generates a prompt for verification of the e-mail address upon detecting that an e-mail address is not present in the memory)." Applicant respectfully submits that in view of the above amendments, this rejection should be withdrawn.

IV. Rejections Under 35 U.S.C. §103(a)**A. Claims 1, 2, and 4-7**

The Office Action rejects claims 1, 2, and 4-7 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hiroki* (U.S. Patent No. 6,594,032) in view of *Cortright* (U.S. Patent No. 6,895,426), including a finding of Official Notice. For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1. A method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:
 - creating an incoming domain name list in a memory;
 - receiving an incoming email communication;
 - extracting a domain name from a sender's email address from the incoming email communication;
 - storing the domain name in the incoming domain name list in the memory;
 - checking if a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication is included in the incoming domain name list in the memory; and

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transmitting the outgoing email communication if the domain name is included in the incoming domain name list, *or otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication.*

(Emphasis Added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the combination of *Hiroki* and *Cortright*, including a finding of Official Notice, does not disclose, teach, or suggest at least *or otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication.*

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

Because independent claim 1 is allowable over the cited references of record, dependent claims 2 and 4-7 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2 and 4-7 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 2 and 4-7 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2 and 4-7 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited

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references of record. Hence there are other reasons why dependent claims 2 and 4-7 are allowable.

Additionally, with regard to the rejection of claims 1, 2, and 4-7, *Stanbach*, which was first provided by Examiner Vu in the latest Examiner Interview, does not make up for the deficiencies of *Hiroki* and *Cortright* noted above. Likewise, with regard to the rejection of claim 1, 2, and 4-7, *Risley*, which was also first provided by Examiner Vu in the latest Examiner Interview, does not make up for the deficiencies of *Hiroki* and *Cortright*. Therefore, claims 1, 2, and 4-7 are considered patentable over any combination of these documents.

In addition, the Office action has included a finding of Official Notice that "the email address includes a recipient's user name and domain name." See *Office Action*, page 4. Applicant traverses this finding in view of the complexity of this area of technology and in view of the specificity of this particular finding, and for those specific reasons, Applicant contends that the subject matter should not be considered well known. Consequently, Applicant respectfully requests that this finding of Official Notice be supported by additional evidence or be withdrawn.

B. Claims 8-17

The Office Action rejects claims 8-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hiroki* (U.S. Patent No. 6,594,032) in view of *Cortright* (U.S. Patent No. 6,895,426). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 8 recites:

8. A method of automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:
- receiving email communications incoming to the email communications server;
 - creating a domain name database;
 - extracting domain names in senders' e-mail addresses from the e-mail communications incoming to the email communications server;
 - storing extracted domain names in the domain name database;

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receiving outgoing e-mail communications from client computers connected to the e-mail communications server through a local network;

searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication provided in the outgoing e-mail communications; and

generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled.

(Emphasis Added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 8 is allowable for at least the reason that the combination of *Hiroki* and *Cortright* does not disclose, teach, or suggest at least ***generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled.***

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 8, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 8 is allowable.

Because independent claim 8 is allowable over the cited references of record, dependent claims 9-17 (which depend from independent claim 8) are allowable as a matter of law for at least the reason that dependent claims 9-17 contain all the steps/features of independent claim 8. Therefore, the rejection to claims 9-17 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 8, dependent claims 9-17 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 9-17 are allowable.

Additionally, with regard to the rejection of claims 8-17, *Stanbach*, which was first provided by Examiner Vu in the latest Examiner Interview, does not make up for the deficiencies

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of *Hiroki* and *Cortright* noted above. Likewise, with regard to the rejection of claims 8-17, *Risley*, which was also first provided by Examiner Vu in the latest Examiner Interview, does not make up for the deficiencies of *Hiroki* and *Cortright*. Therefore, claims 8-17 are considered patentable over any combination of these documents.

C. Claims 21 and 23-25

The Office Action rejects claims 21 and 23-25 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hiroki* (U.S. Patent No. 6,594,032) in view of *Cortright* (U.S. Patent No. 6,895,426). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 21 recites:

21. A method of automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:

- creating an incoming email address list in a memory;
- receiving an incoming email communication;
- storing, in the incoming email address list in the memory, an email address extracted from the incoming email communication;
- checking if an e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the incoming email address list in the memory; and
- transmitting the outgoing email communication if the e-mail address is included in the incoming email address list, *or otherwise generating a prompt for a user to confirm an e-mail address if the domain name is not included in the incoming email address list.*

(Emphasis Added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 21 is allowable for at least the reason that the combination of *Hiroki* and *Cortright* does not disclose, teach, or suggest at least *or otherwise*

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generating a prompt for a user to confirm an e-mail address if the domain name is not included in the incoming email address list.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 21, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable.

Because independent claim 21 is allowable over the cited references of record, dependent claims 23-25 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 23-25 contain all the steps/features of independent claim 21. Therefore, the rejection to claims 23-25 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 23-25 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 23-25 are allowable.

Additionally, with regard to the rejection of claims 21 and 23-25, *Stanbach*, which was first provided by Examiner Vu in the latest Examiner Interview, does not make up for the deficiencies of *Hiroki* and *Cortright* noted above. Likewise, with regard to claims 21 and 23-25, *Risley*, which was also first provided by Examiner Vu in the latest Examiner Interview, does not make up for the deficiencies of *Hiroki* and *Cortright*. Therefore, claims 21 and 23-25 are considered patentable over any combination of these documents.

D. Claims 26-28

The Office Action rejects claims 26-28 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hiroki* (U.S. Patent No. 6,594,032) in view of *Cortright* (U.S. Patent No. 6,895,426). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 26 recites:

26. An e-mail communications system stored in a client computer for automatically checking for incorrect e-mail addresses provided in outgoing e-mail

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communications from the client computer prior to transmission to an e-mail server, comprising:

- an address extractor for extracting senders' e-mail addresses from incoming e-mail communications;

- a previous sender addresses memory for storing e-mail addresses extracted from senders' e-mail addresses in incoming e-mail communications; and

- a checker for searching the previous sender addresses memory for e-mail addresses of intended recipients that are provided in outgoing e-mail communications,

wherein the checker generates a prompt for verification of an e-mail address of an intended recipient upon detecting that an e-mail address of an intended recipient in an outgoing e-mail communication is not present in the previous sender addresses memory.

(Emphasis Added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 26 is allowable for at least the reason that the combination of *Hiroki* and *Cortright* does not disclose, teach, or suggest at least *wherein the checker generates a prompt for verification of an e-mail address of an intended recipient upon detecting that an e-mail address of an intended recipient in an outgoing e-mail communication is not present in the previous sender addresses memory.*

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 26, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 26 is allowable.

Because independent claim 26 is allowable over the cited references of record, dependent claims 27 and 28 (which depend from independent claim 26) are allowable as a matter of law for at least the reason that dependent claims 27 and 28 contain all the steps/features of independent

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claim 26. Therefore, the rejection to claims 27 and 28 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 26, dependent claims 27 and 28 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 27 and 28 are allowable.

Additionally, with regard to the rejection of claims 26-28, *Stambach*, which was first provided by Examiner Vu in the latest Examiner Interview, does not make up for the deficiencies of *Hiroki* and *Cortright* noted above. Likewise, with regard to the rejection of claims 26-28, *Risley*, which was also first provided by Examiner Vu in the latest Examiner Interview, does not make up for the deficiencies of *Hiroki* and *Cortright*. Therefore, claims 26-28 are considered patentable over any combination of these documents.

V. Miscellaneous Issues

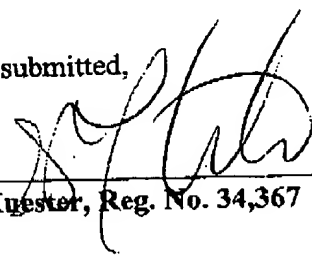
Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1, 2, 4-21, and 23-28 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,


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